

REMARKS/ARGUMENTS

In a non-final Office Action dated December 28, 2004 claims 29-31 were pending and claims 29-31 were rejected. Specifically, the Examiner rejected the priority claim to United States Patent Application Serial No. 09/502,344, filed February 10, 2000, entitled "Nucleic Acid Ligands," now U.S. Patent No. 6,331,398. The Examiner also rejected claims 29-31 under 35 U.S.C. § 103(a). Claims 29-31 also stand rejected under the judicially created doctrine of obviousness-type double patenting.

The Information Disclosure Statement

The Examiner notes that Reference AAC (Tucker et al. (Sept. 1999) J. of Chromatography 732:202-212) on PTO Form 1449 filed on 2/4/2002 has not been supplied. A copy of the reference is now enclosed with this response.

The Priority Claim

The instant application is a divisional of United States Patent Application Serial No. 09/364,539, filed July 29, 1999, entitled "Nucleic Acid Ligands which Bind to Hepatocyte Growth Factor Scatter Factor (HGF/SF) or its Receptor C-Met," which is a continuation-in-part of United States Patent Application Serial No. 09/502,344, filed February 10, 2000, entitled "Nucleic Acid Ligands," now U.S. Patent No. 6,331,398, which is a continuation of United States Patent Application Serial No. 08/469,609, filed June, 6, 1995, entitled "Method for Detecting a Target Molecule in a Sample Using a Nucleic Acid Ligand," now U.S. Patent No. 5,843,653, which is a continuation of United States Patent Application Serial No. 07/714,131, filed June 10, 1991, entitled "Nucleic Acid Ligands," now U.S. Patent No. 5,475,096, which is a continuation-in-part of United States Patent Application Serial No. 07/536,428, filed June 11, 1990, now abandoned. The Examiner has denied the claim of priority to United States Patent Application Serial No. 09/502,344, stating that while this application discloses the SELEX method it does not disclose the instantly claimed target, c-met. Applicants respectfully disagree.

Under 35 U.S.C. § 120, the claims in a U.S. application are entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the

manner provided by 35 U.S.C. § 112, first paragraph in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). Applicants respectfully submit that United States Patent Application Serial No. 09/502,344 does disclose the subject matter of claims 29-31 in accordance with 35 U.S.C. § 112. Specifically, 09/502,344 (now U.S. Pat. No. 6,331,398) discloses that the SELEX method may be used to generate nucleic acid ligands to a wide variety of proteins. For example, column 8, lines 16-24 of U.S. Pat. No. 6,331,398 states:

In more specific embodiments, the SELEX method provides a rapid means for isolating and identifying nucleic acid ligands which bind to proteins, including both nucleic acid-binding proteins and proteins not known to bind nucleic acids as part of their biological function.

Application Serial No. 09/502,344 specifically teaches that the SELEX method may be used to generate nucleic acid ligands to the genus of mammalian receptors (see Example 5 at column 42, line 49- column 43, line 12). The same teachings are found in the earlier priority applications United States Patent Application Serial No. 08/469,609, filed June, 6, 1995, entitled "Method for Detecting a Target Molecule in a Sample Using a Nucleic Acid Ligand," now U.S. Patent No. 5,843,653, which is a continuation of United States Patent Application Serial No. 07/714,131, filed June 10, 1991, entitled "Nucleic Acid Ligands," now U.S. Patent No. 5,475,096, which is a continuation-in-part of United States Patent Application Serial No. 07/536,428, filed June 11, 1990, now abandoned.

One skilled in the art would be well aware that the c-met proto-oncogene product is a mammalian receptor, specifically a receptor tyrosine kinase (see Park et al. *Sequence of MET protooncogene cDNA has features characteristic of the tyrosine kinase family of growth-factor receptors*, Proc. Natl. Acad. Sci. 84: 6379-83 (1987) (copy enclosed). One skilled in the art would recognize that the priority application discloses the instantly claimed invention in accordance with the requirements of 35 U.S.C. § 112, first paragraph *i.e.* the priority application describes the instantly claimed invention in sufficient detail that one skilled in the art could reasonably conclude that the inventors had possession of a method that could be used to generate nucleic acid ligands to all mammalian receptors, including the c-met proto-oncogene product; and that the priority application provides a disclosure that would allow one skilled in the art to

perform the SELEX process using any mammalian receptor, including the c-met proto-oncogene product. Therefore, Applicants respectfully submit that the priority claim in the instant application is proper, and that the effective filing date of the instant application is June 11, 1990.

The 35 U.S.C. § 103(a) Rejection

The Examiner rejected claims 29-31 under 35 U.S.C. § 103(a) as being obvious in view of Gold et al. (U.S. Pat. No. 5,270,163) in view of Bottaro et al, further in view of Faletto et al., further in view of Toothman et al. (U.S. Pat. No. 5,731,424), Jayasena et al. (U.S. Pat. No. 5,734,034), or Pagratis et al. (U.S. Pat. No. 5,837,834). In view of the June 11, 1990 effective filing date of the instant application, Gold et al. is not a proper prior art reference (Gold et al. has a filing date of August 17, 1992, and issued on December 14, 1993). Withdrawal of the 35 U.S.C. § 103(a) rejection is respectfully requested.

The Obviousness-Type Double Patenting Rejection

Claims 29-31 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Gold et al. in view of Faletto et al. and Bottaro et al. In the interests of expediting allowance, Applicants hereby enclose a terminal disclaimer in respect of commonly-assigned U.S. Pat. No. 5,270,163. Withdrawal of the double patenting rejection is respectfully requested.

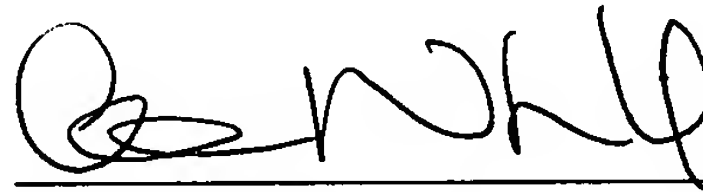
Closing Remarks

Applicant believes that the pending claims are in condition for allowance. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The fee for the submission of a terminal disclaimer is \$130 (37 C.F.R. § 1.20(d)). A check in the amount of \$130 is enclosed.

The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,



Date: March 28, 2005

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